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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/512,035	10/20/2004	Gotz-Ekkehard Sapper	PAT-01023	2224
77224	7590	01/05/2009		
Mary E. Golota Cantor Colburn LLP 201 W. Big Beaver Road Suite 1101 Troy, MI 48084			EXAMINER RONESL VICKERY M	
			ART UNIT 1796	PAPER NUMBER
			NOTIFICATION DATE 01/05/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/512,035

Applicant(s)

SAPPER ET AL.

Examiner

VICKEY RONESI

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1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/10/2008 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to claims 1 and 18, the property of “shows not settling after six months” for the claimed composition fails to satisfy the written description requirement of 35 USC 112, first paragraph since there does not appear to be a written description requirement of the phrase with

respect to the generic claimed composition in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163. While there is support for specific exemplified compositions Example 1 and Example 2 on the last page of the specification showing no settling after six months, there is no support for a composition encompassed within the scope of the instant claims not showing settling after six months.

With respect to claims 2-17, they are rejected for being dependent on a rejected claim.

Claim Rejections - 35 USC § 103

4. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sapper (US 6,284,037) in view of Bergfried (CA 2,154,818).

Sapper discloses an additive for coating formulations with binder used in basecoat materials comprising a nonassociative rheology stabilizer such as exemplified Viscalex HV 30 (like presently used having methacrylic acid content of 40-60 wt %), mica pigment, water, polypropylene glycol as nonionic surfactant, and polyurethane binder (col. 4, lines 25-65). Sapper further teaches the use of tertiary amine compounds such as dimethylethanolamine to control pH (col. 4, line 63 to col. 4, line 5). The organic solvents are only preferred emulsifiers and are not necessarily present (col. 3, lines 20-22). The amounts of mica, nonassociative thickener, and nonionic in the exemplified coating composition overlap with the presently claimed amounts in the coating composition of claim 15.

Sapper does not disclose (i) preparing a pigment paste without binder and comprising mica, nanoassociative rheology stabilizer, nonionic surfactant, and amine compounds and (ii) an amount of 15-25 wt % mica pigment.

With respect to (i), Bergfried discloses a pigment concentrate comprising a pigment, 0-2.0 wt % thickener based on polyacrylate (i.e., Sapper's nonassociative stabilizer), 0.1-0.9 wt % nonionic surfactant, 0.1-4.9 wt % amine, and water (page 3, lines 1-27)—wherein the pigment paste is added to binder resin (page 2, lines 9-12) to effect appropriate mixing.

Given that Sapper discloses a stabilized composition comprising mica, nonassociative thickener, nonionic surfactant, amine, and water and further given that pigment pastes are known to contain such ingredients before being added to a binder as taught by Bergfried, it would have been obvious to one of ordinary skill in the art to prepare the presently claimed pigment paste before adding to a binder to prepare a coating composition and thereby have a pigment paste that intrinsically shows no settling after six months.

With respect to the (ii), when Paint 2 is combined with 0.098 wt % Viscalex HV 30 in the examples of Sapper, the relative amount of mica to thickener is 30.6:1. The presently claimed amount provides for a ratio of mica to thickener of 20:1 to 125:1. Therefore, the relative amount of mica in the paint to thickener is encompassed by the presently claimed relative amounts of mica to thickener in the pigment paste. Therefore, one of ordinary skill in the art would utilize an appropriate (and relatively higher) amount of mica relative to thickener in order to prepare a pigment paste as taught by Bergfried to be added to the coating formulation of Sapper.

Response to Arguments

5. Applicant's arguments filed 12/10/2008 have been fully considered but they are not persuasive. Specifically, applicant argues (A) that Sapper does not teach a pigment paste; (B) that neither Sapper nor Bergfried teaches a pigment paste showing no settling after six months;

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and (C) that Sapper discloses only very low amounts of mica which do not read on the presently claimed amount of 15-25 wt %;

With respect to (A), given that Sapper discloses a composition comprising mica, nonassociative thickener, nonionic surfactant, amine, and water and further given that pigment pastes are known to contain such ingredients before being added to a binder as taught by Bergfried, it would have been obvious to one of ordinary skill in the art to prepare the presently claimed pigment paste before adding to a binder to prepare a coating composition because changing the mixing order is *prima facie* obvious since the end-product is the same. Therefore, while Sapper discloses mixing all of the ingredients at once, it is the examiner's position that it would have been obvious to one of ordinary skill in the art to do a staged mixing process and thereby obtain an intermediate product (i.e., pigment paste) that reads on the presently claimed pigment paste that is added to the coating formulation of Sapper.

With respect to (B), while Sapper and Bergfried do not teach the specific timeline of six months with respect to no settling, Sapper and Bergfried both teach improved stabilization by using the presently claimed nonassociative thickener with solid pigments. Therefore, given that the combined teachings of Sapper and Bergfried provide for the presently claimed pigment paste composition, it would have naturally flowed from their teachings that the composition not show settling after six months.

With respect to argument (C), Sapper discloses 3 wt % mica when present in a coating formulation. The motivation to have the presently claimed higher concentration of mica is provided by Bergfried which teaches pigment concentrates which are diluted to provide coating formulations like Sapper with necessarily lower concentrations of mica. Furthermore, note that

the amount of mica used in the presently claimed coating material (2-6 wt %) overlaps with the 3 wt % disclosed by Sapper. Therefore, it is evident that Sapper does not disclose concentrations of mica in a coating formulation that are too low.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

12/29/2008
vr

/Vickey Ronesi/
Examiner, Art Unit 1796